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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,717	12/24/2003	Sadami Okada	118182	8330

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OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
ALEXANDRIA, VA 22320

EXAMINER
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WHIPKEY, JASON T

ART UNIT	PAPER NUMBER
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2622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/743,717	<b>Applicant(s)</b> OKADA	
	<b>Examiner</b> Jason T. Whipkey	<b>Art Unit</b> 2622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                       |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.                                                |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 12-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 12-14 define a computer program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory. The scope of the presently claimed computer program can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 7 recites the limitation “the predetermined specific information” on line 2. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, the claim will be treated as if it reads, “the predetermined specific image”.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 7, 8, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Murakami (Japanese Patent Publication No. 2002-281435).

Regarding **claims 1 and 11**, Murakami discloses an electronic camera (see page 6, line 44 of the provided computer translation) that creates an image file (see page 8, line 39) by processing image data obtained through an image-capturing operation, comprising:

an image-capturing unit (a solid-state image sensor) that generates the image data by capturing a subject image (see page 8, line 20);

a data extraction unit (alphabetic character merge part 103 and image data extraction part 201; see Drawing 1) that sets an image plane range corresponding to an image portion of the image data (see page 8, lines 29-30) and extracts data of the image portion in the image plane range (see page 8, lines 32-34);

a data insertion unit (alphabetic character merge part 103) that writes data of a predetermined specific image (see page 8, lines 23-25) over the image plane range of the image data and generates data of a processed image (see page 8, lines 29-30); and

a file creation unit (record treater 104) that creates an image file (see page 8, line 39) by storing the data of the processed image into an image data area of the image file, which is referenced as image data and storing the data of the image portion into a non-image data area (a header) of the image file which is not referenced as image data (see page 7, lines 24-27).

Regarding **claim 7**, Murakami discloses:

the predetermined specific information includes at least information indicating a photographer name or a photographing date/time (see page 8, lines 23-25).

Regarding **claim 8**, Murakami discloses an image processing method for restoring an image comprising steps of:

obtaining the image file created in an electronic camera (see page 8, lines 43-44) according to claim 1 (described *supra*);

reading out the data of the processed image from the image data area of the image file (see page 8, lines 44-46);

reading out the data of the image portion from the non-image data area (the header) of the image file (see page 9, lines 3-4);

specifying the data of the specific image in the data of the processed image (see page 9, lines 12-19); and

writing the data of the image portion over the specified data of the specific image (see *id.*).

**Claim 12** can be treated like claim 8. Additionally, Murakami discloses that his invention can be implemented using software (see page 11, lines 32-33).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 6, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Steinberg (U.S. Patent No. 5,862,218).

**Claim 2** can be treated like claim 1. However, Murakami is silent with regard to encrypting the data of the image portion.

Steinberg discloses a digital camera that stores additional data, wherein:

the file creation unit includes an encryption unit that encrypts the data of the image portion (an indicium) and stores the data encrypted by the encryption

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unit into the non-image data area (a header; see column 3, line 64, through column 4, line 12).

As stated in column 2, lines 61-67, an advantage of encrypting replacement data stored in a header is that the original image can only be viewed by an authorized person. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Murakami's device perform encryption on the data stored in the header.

**Claim 6** can be treated like claim 1. However, Murakami is silent with regard to the specific information including copyright information.

Steinberg discloses a digital camera that stores additional data, wherein:

the predetermined specific image includes information related to copyright  
(see Figure 4 and column 6, lines 25-27).

As suggested in column 4, lines 1-2, an advantage of inserting such a marker is that unauthorized use of the original image can be deterred. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Murakami's device insert a copyright notice.

**Claim 9** can be treated like a combination of claims 2 and 8. However, Murakami is silent with regard to decrypting encrypted data.

Steinberg discloses:

reading out the encrypted data of the image portion from the non-image  
data area of the image file (see column 8, lines 37-40);

obtaining the data of the image portion by decrypting the encrypted data of  
the image portion (see *id.*).

**Claim 13** can be treated like claim 9. Additionally, Murakami discloses that his invention can be implemented using software (see page 11, lines 32-33).

9. Claims 3, 4, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Yamada (U.S. Patent Application Publication No. 2002/0051140).

**Claim 3** may be treated like claim 1. Additionally, Murakami discloses:

the data extraction unit extracts data corresponding to the image plane range from the data as data of the image portion (see page 8, lines 29-34).

While Murakami discloses that compression is performed (see page 8, lines 30-31), he is silent with regard to writing compressed data to a range of compressed data.

Yamada discloses an image encoding apparatus (see Figure 10), including:

an image compression unit that generates compressed data (C6) by executing image compression on the image data generated by the image-capturing unit (see paragraph 127), wherein:

the data insertion unit writes compressed data (C8) of the specific image over the data corresponding to the image plane range in the compressed data (CDD; see paragraph 131).

As suggested in paragraphs 16-19, an advantage of writing compressed data to a range of compressed data is that the data need not be decompressed and recompressed, thereby avoiding the need for additional memory. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Murakami's system write compressed data to a range of compressed data.



Regarding **claim 4**, Yamada discloses:

the image compression unit inserts marker code (restart marker RM) indicating a position within an image plane in the image data while generating the compressed data (see paragraph 129);

the data extraction unit extracts the data corresponding to the image plane range as the data of the image portion based upon the marker code (see paragraph 131); and

the data insertion unit writes the compressed data of the specific image over the data corresponding to the image plane range based upon the marker code (see paragraphs 131-132).

**Claim 10** can be treated like a combination of claims 4 and 8. Additionally, Yamada discloses:

reading out the compressed data (C8) stored as the data of the image portion from the non-image data area (see paragraph 131);

specifying the compressed data of the specific image contained in the compressed data based upon the marker code included in the compressed data (see *id.*); and

writing the compressed data constituting the data of the image portion having been read out over the specified compressed data of the specific image (see *id.*).

**Claim 14** can be treated like claim 10. Additionally, Murakami discloses that his invention can be implemented using software (see page 11, lines 32-33).

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Fox (U.S. Patent No. 6,888,569).

**Claim 5** can be treated like claim 1. However, Murakami is silent with regard to using a JPEG file.

Fox discloses a digital photographing system that stores data with images. The JPEG format is used (see column 4, lines 55-56), which allows additional data to be stored (see column 4, lines 16-40) with image data. As suggested in column 5, lines 14-28, an advantage of using the JPEG format is that it is flexible enough to allow third party applications to use the additional data area as they see fit. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Murakami's system use the JPEG file format.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Whipkey, whose telephone number is (571) 272-7321. The

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examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:30 P.M. eastern daylight time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava, can be reached at (571) 272-7304. The fax phone number for the organization where this application is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTW

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March 26, 2007

  
TUAN HO  
PRIMARY EXAMINER